REMARKS

The Office Action dated April 8, 2009 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

In accordance with the foregoing, claims 22, 39, 44, and 46 have been amended and claims 49-52 have been added to more particularly point out and distinctly claim the subject matter of the invention. Claim 35 has been cancelled, without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 22-33, 36-37, and 39-52 are pending and under consideration.

OBJECTIONS TO THE CLAIMS:

In the Office Action, claim 35 was objected to for a minor informality. Claim 35 has been cancelled, without prejudice or disclaimer. Accordingly, it is respectfully requested that the objection to the claim is moot.

REJECTIONS UNDER 35 U.S.C. § 112:

The Office Action rejected claim 44 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. The Office Action alleged that there is no support in the specification for a computer readable medium, as recited in claim 44. This rejection is respectfully traversed.

The written description requirement is governed by §2163.02 of the MPEP, entitled "Standard for Determining Compliance With the Written Description Requirement", which proceeds by noting that "The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

As noted previously, page 16, lines 18-22 of the original specification as filed discloses "Consequently, in a mobile-originated case, the mobile station MS itself analyses the service request, which is issued by, for example, application software or the terminal (TE)." The MS is disclosed as analyzing the service request, which is

"software." For the MS to analyze the service request, which is disclosed in the specification as "application software", clearly the MS is capable of processing software and hence includes a processor. In addition, in order for software to be read or executed, it must first be contained on a computer readable medium. These fundamental software execution and processing operations are well established to those persons of ordinary skill in the art. Accordingly, the description in the specification as filed meets the written description requirement as recognized by *In re Gosteli*, since one having ordinary skill in the art would recognize the processing and execution of software to require a computer readable medium and a processor, as recited in claim 44.

Applicant respectfully requests that the rejection to the claim be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 22-33, 36, 37 and 39-46 were rejected under 35 U.S.C. §102(b) as being anticipated by Lintulampi (WO 98/59513), hereinafter Lintulampi. The Office Action took the position that Lintulampi discloses all of the elements of the claims. This rejection is respectfully traversed for at least the following reasons.

Claim 22, upon which claims 23-33, 36-37, 45, 47, and 49 are dependent, recites a method, including detecting a request for specific service for a radio transceiver device, wherein said radio transceiver device is configured to operate with a first radio access network and a second radio access network and is attached to said first radio access network, and accessing information on conditions for the first radio access network and

the second radio access network for giving sufficient support for a specific service requested by said request for specific service. The method further includes providing information between the radio transceiver device and the network side about service availability in the second radio access network, and analyzing whether or not said first radio access network and said second radio access network meet said conditions. The method includes initiating a handover from said first radio access network to said second radio access network if the conditions are met by the second radio access network but the first radio access network does not.

Claim 39, upon which claims 40-43 are dependent, recites an apparatus, including a detector configured to detect a request for specific service for a radio transceiver device, wherein said radio transceiver device is configured to operate with a first radio access network and a second radio access network and is attached to said first radio access network, and an analyzer responsive to said detector. The analyzer is configured to access information on conditions for said first and said second radio access networks for giving sufficient support for the specific service requested by said request for specific service, provide information between the radio transceiver device and the network side about service availability in the second radio access network, and analyze whether or not said first radio access network and said second radio access network meet the conditions. The apparatus also includes an initiator responsive to said analyzer, the initiator being configured to initiate a handover from said first radio access network to said second radio

access network if the respective conditions are not met by said first radio access network but by said second radio access network.

Claims 44 and 46 recite a computer program claim and a means-plus-function claim which are comparable to method claim 22 and apparatus claim 39, respectively.

As will be discussed below, Lintulampi fails to disclose or suggest all of the elements of the claims, and therefore fails to provide the features discussed above. The rejection is respectfully traversed for at least the following reasons.

Lintulampi generally describes a method of operating a dual mode mobile phone. On page 2, Lintulampi describes that there are two networks. The first and second networks provide a first and second sets of services in a particular geographical area. Therefore, when a service of the first set is requested, the device is registered with the first network, and when a service of the second set but of the first set is requested, the device is registered with the second network.

In contrast thereto, according to the present invention as recited in independent claims 22, 39, 44, and 46, a handover is performed from the first network to the second network. In particular, Lintulampi fails to teach or suggest, at least, "initiating a handover from said first radio access network to said second radio access network if the conditions are met by the second radio access network but the first radio access network does not," as recited in independent claim 22 and similarly recited in independent claims 39, 44, and 46. This feature is not taught or suggested in Lintulampi because, in Lintulampi, the radio transceiver device may stay registered in the first network and make continued to

use services that a supported by the first network. Moreover, a further difference to Lintulampi is that the radio transceiver device may already be registered to the second network, and it may be only the service that is handled over to the second network.

Furthermore, as derivable from page 2, line 31, to page 3, line 2, according to Lintulampi, the mobile communication device has to be configured to know or even has to be informed by the user about the service availability in the second network.

In contrast thereto, as recited in independent claim 22 and similarly recited in independent claims 39, 44, and 46, Lintulampi fails to teach or suggest, at least, "providing information between the radio transceiver device and the network side about service availability in the second radio access network; analyzing whether or not said first radio access network and said second radio access network meet said conditions." In the present claims, this information is provided by the network. That is, in particular, when the method according to the invention is carried out in the radio transceiver device itself, the information regarding these services is provided as necessary. For example, as described in on page 19, line 32, to page 20, line 10 of the original PCT application (corresponding to paragraph [0077] of the printed US application), a mechanism is defined, in which the network informs the radio transceiver device about the service availability in the second radio access network. For example, this can be performed during a call set up. That is, in this way, the radio transceiver device is always reliably informed about possible services in the second network.

In contrast thereto, according to Lintulampi, either the user has to know somehow about the services in the second network, or the mobile station is correspondingly preconfigured. In any case, this is troublesome for the user, since he has to guess which services are provided.

Thus, according to the present invention, it is possible to easily obtain the necessary information and to perform a handover of the service. This measure are neither shown nor suggested by Lintulampi.

Therefore, Lintulampi fails to teach or suggest all the features of the present independent claims including, "providing information between the radio transceiver device and the network side about service availability in the second radio access network; analyzing whether or not said first radio access network and said second radio access network meet said conditions; and initiating a handover from said first radio access network to said second radio access network if the conditions are met by the second radio access network but the first radio access network does not."

For at least the reasons discussed above, Applicant respectfully submits that the cited references fail to disclose or suggest all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unanticipated. It is therefore respectfully requested that all of claims 22-33, 36, 37 and 39-46 be allowed, and this application passed to issue.

Claims 35, 47 and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lintulampi. Applicant respectfully traverses this rejection.

The Office Action indicated that Lintulampi describes the features of the independent claims from which claims 35, 47, and 48 depend from, except for the particular features recited in claims 35, 47, and 48. To resolve the deficiencies of Lintulampi, the Office Action then took the Official Notice that the features recited in claims 35, 47, and 48 are well known in the art. This rejection is respectfully traversed for at least the following reasons.

Claim 35 has been cancelled, without prejudice or disclaimer. Therefore, the rejection to this claim is rendered moot. Dependent claim 47 depends from independent claim 22 and dependent claim 48 depends from claim 39. The arguments presented above supporting the patentability of independent claims 22 and 39 are incorporated herein.

It is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section. *See In re Lee*, 61 USPQ2d 1430 (CA FC 2002) (*citing In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775).

If the U.S. Patent and Trademark Office wishes to take Official Notice that the features of claim 47 reciting that "wherein an error procedure is initiated, when it is detected in said analyzing that said requested specific service is not available in any of said networks" and that the features of claim 48 reciting that "wherein the apparatus is configured to initiate an error procedure, when it is detected in said analyzer that said

requested specific service is not available in any of said networks," are notoriously well known, Applicant respectfully requests to the U.S. Patent and Trademark Office that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

While "Official Notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. According to MPEP 2144.03, "the examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art," emphasis added. However, if the Applicant, according to MPEP 2144.03 traverses such an assertion the Examiner should cite a reference in support of his or her position. In short, the rules of the U.S. Patent and Trademark Office do not allow discretion on the part of the Examiner. Accordingly, the Applicant respectfully traverses such rejection and requests that either the Examiner must support his assertion with an Affidavit or withdraw the rejection.

The outstanding rejection would appear to have taken the teachings of the present invention and applied the same to modify Lintulampi, as set forth in the Office Action, to then disclose the presently claimed invention. Applicant respectfully asserts that the *prima facie* burden has not been met.

In view of the foregoing, it is respectfully requested that claims 47 and 48 be allowed.

CONCLUSION:

In view of the above, Applicant respectfully submits that the claimed invention recites subject matter which is neither disclosed nor suggested in the cited prior art. Applicant further submits that the subject matter is more than sufficient to render the claimed invention unobvious to a person of skill in the art. Applicant therefore respectfully requests that each of claims 22-33, 36-37, and 39-52 be found allowable and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: Request for Continued Examination
Petition for Extension of Time
Additional Claim Fee Transmittal